

**REMARKS**

Claims 1-3 are pending in this application. By this Amendment, the specification, figures and claims are amended. Claims 4-9 are canceled without prejudice to or disclaimer of the subject matter recited therein. Claim 1 is amended to correct a typographical error. Thus no new matter is added.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

**I. Drawing Objections**

The drawings filed on November 3, 2004, were unacceptable by the Examiner for allegedly introducing new matter. Although the allegation that new matter was introduced in the previously submitted figures is traversed, original Fig. 1 is revised as indicated on the Replacement Sheet. New Figs. 5 and 6 are submitted.

Fig. 1 is revised to indicate the feature of the "base area" as reference character 28. As the base area is described in the original specification and recited in the original claims, merely identifying the base area through a reference character does not introduce new matter.

Figs. 5 and 6 provide enlargements of original Fig. 1 to aid in the visualization of the features shown in the original figure. Thus, no new matter is added.

**II. Specification Objections**

The Office Action objects to the specification for allegedly introducing new matter into the disclosure. The specification is amended in reply to the objection to remove reference numbers previously added to identify the features shown in the original claims. The

specification is further amended to remove description of Figs. 7 and 8 which were submitted in response to a previous Office Action and not accepted.

**III. Claim Objections**

Claims 1-9 are objected to due to an alleged grammatical or typographical error in claim 1. Claim 1 is amended in response to the objection.

**IV. Claim Rejections Under 35 U.S.C. §112**

Claims 4-9 are rejected under 35 U.S.C. §112, first paragraph. As claims 4-9 are canceled the rejection of those claims is moot.

**V. Claim Rejections Under 35 U.S.C. §103**

Claims 1-3 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Design Patent D284,259 to Oury. The rejection is respectfully traversed.

Oury does not disclose or suggest each and every feature recited in original claim 1 or in claim 1 as amended. For example, Oury does not disclose or suggest a hand grip adapted for a non-rotatable fitting onto a motorcycle handlebar end section, the hand grip comprising *inter alia*, ... projections progressively decreasing in a base area and in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body.

Although the Office Action rejects claims 1-3 and 10 over Oury, the Office Action admits that Oury discloses projections progressively increasing in height from adjacent the flange to adjacent the second area. In addition to the admitted structural distinction between the applied reference and the claimed subject matter, Oury also discloses that the base area increases from adjacent the flange to the second end.

The Office Action alleges that it is "common knowledge" in the art at the time the invention was made to decrease, instead of to increase, the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the grip.

"It is never appropriate to rely totally on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." See MPEP §2144.03 citing In re Zurko, 258 F.3d at 1385, 59 USPQ 2d at 1697. As the Office Action fails to provide evidentiary support for such common knowledge, Applicant submits that such a rejection is improper.

In the outstanding Office Action at page 12, which appears to be the Examiner's comments to the previous Amendment, the Office Action alleges that U.S. Design Patent D461,390 "shows that the projections that decrease in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body is well known." However, Livingston fails to disclose a hand grip comprising ... an annualr flange projecting radially outwards at the first, open end, the cylindrical body also having an external surface formed with a plurality of projections distributed there over, the projections progressively decreasing in a base area and in height from adjacent the flange to the second end so as to provide an external taper to the body, as recited in the rejected claims.

Rather, as clearly shown in the figures of the design patent to Livingston, the base area increases from the flange and then decrease again at the second end. It also appears from the figures of Livingston that the height increases from the flange and then rapidly decreasing at the second end. Furthermore, there is no disclosure in Livingston that it is the projections which provide the external taper. Thus, the reliance of Livingston as showing that it is 'common knowledge' to have the structural features recited in the rejected claims fails.

The Office Action further relies on Figs. 2 and 3 of U.S. Patent 5,261,665 to Downey to show that projections decrease in height from adjacent to flange to adjacent to second end are common knowledge. However, Figs. 2 and 3 of Downey disclose elevational views of a die for forming a golf club grip socket. The golf club grip disclosed in Downey has no annular flange as recited in the rejected claims, nor do the projections on the golf club grip die

decrease in base area from adjacent a flange to adjacent a second end. Furthermore, the motorcycle hand grip recited in the rejected claims describe a hollow cylindrical body having a first open end and an annular flange projecting radially outwards at the first open end.

Downey fails to disclose such an open end. Thus, Downey does not support the allegation in the Office Action that it is "common knowledge" to decrease instead of increase the height of projections.

The Office Action further contends that although Oury's projections progressively increase instead of decrease in height from adjacent the flange to adjacent the second end, that the reversal/rearrangement of the height of Oury's projections would have been "a matter of choice of design since the claims structures and the function they perform are the same as the prior art".

The claimed structure and function in Oury is not the same as that of the subject matter of the claims. First, as Oury merely discloses ornamentation on the cycle handle grip, no function of such ornamentation can, or may be, claimed. Rather, by definition, a design application cannot claim a function, but rather is merely for ornamentation. Second, the decrease in height of the projections from adjacent the flange to adjacent the second end as recited in the claims is not merely a design choice as such a decrease in height provides the external taper to the body, as recited in the rejected claims. Thus, increasing the height of the projections, as in Oury actually "teaches away" from the claimed subject matter.

The Office Action alleges that it is proper to rely on the figures of the design patent in rejecting the claims of a utility patent and cites In re Mraz, 173 USPQ 25 (CCPA 1972). In setting forth the rejection, the Office Action misstates the holding of In re Mraz when alleging that it recites "drawings in a design patent can anticipate or make obvious the claimed invention" (emphasis added). Rather, the cited passage correctly recites that "drawings and pictures can anticipate claims if they clearly show the structure which is claimed" (MPEP

§2125) (emphasis added). Thus, the reliance on In re Mraz is improper as the figures in the design patent of Oury are relied upon to form the basis of an obviousness-type rejection, rather than to anticipate the claims as was the holding in In re Mraz.. Additionally, the cited section of MPEP §2125 further recites that "however, the picture must show all the claimed structural features and how they are put together". As Oury is merely a design patent, it is Oury fails to "show all the claimed structural features and how they are put together".

Furthermore, MPEP §2125 goes on to state that "it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue". As there is no specification in a design patent, they can be no description of precise proportions. Furthermore, as the drawings of Oury fail to disclose the specific features recited in the claims, the drawings of Oury do not render obvious the subject matter of the rejected claims.

As clearly provided in the specification "by making the region adjacent the flange 14 somewhat thicker, particularly making this extra thickness from the soft rubber compound, extra cushioning on the rider's hand is provided in exactly the region of greatest pressure and greatest wear, i.e., below the arch formed by thumb and forefinger. Also because there is more material, this region does not wear down, split and fail as quickly as hitherto in the case of substantially constant external diameter grips." Thus, the arrangement of the projections as recited in the claims is not merely design choice, but provides the structure necessary to overcome the deficiencies of known motorcycle grips.

Regarding claim 2, the Office Action alleges that Oury teaches the invention substantially as claimed and admits that Oury does not teach an external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end. However, the Office Action again alleges that it is "common knowledge" to form

the external diameter as recited in claim 2. As stated above, it is never appropriate to rely solely on common knowledge in the art without evidentiary support on the record.

The Office Action goes on to indicate that the size or dimension of the external diameter of the cylinder body would have been of matter of design choose since the claim structures and the functions they performed are the same as the prior art. However, as the relied upon prior art is merely a design patent, there is no functionality in the pictures but rather, the design patent is for ornamental features only. Furthermore, as stated above, MPEP §2125 specific cites that it is well established that patent drawings do not define the precise proportion of the elements and may not be relied upon to show particular sizes if the specification is completed silent on the issue. Therefore, reliance on Oury for disclosing or teaching the specific dimensionally features recited in the rejected claim is improper.

Furthermore, to imbue one of ordinary skill in the art with knowledge of the invention when no prior art reference or references of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome where in that which only the inventor taught is used against its teacher. W. L. Gore and Associates v. Garlock, Inc. 721 F.2 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Accordingly, Applicant respectfully requests the rejection of claims 1-3 under 35 U.S.C. §103(a) be withdrawn.

#### **VI. Claim Rejections under 35 U.S.C. §103**

Claims 4 and 7 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of admitted prior art; claims 4, 5, 7 and 8 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of U.S. Patent 4,416,166 to Jannard et al. As claims 4-8 are canceled, the rejection of those claims is moot.

**VII. Allowable Subject Matter**

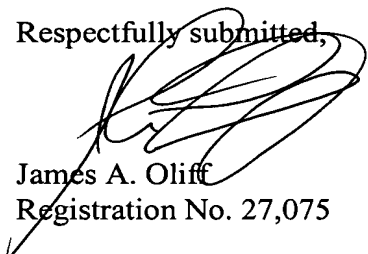
Claims 6 and 9 have been indicated as allowable to be rewritten to overcome the rejections under 35 U.S.C. §112, first paragraph. Claims 6 and 9 are canceled in this Amendment.

**VIII. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
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**Amendments to the Drawings:**

The attached replacement drawing sheet makes changes to Fig. 1 and replaces the original sheet with Figs. 1 and 2. An added sheet shows new Figs. 5 and 6.

Attachment: Replacement Sheet/Added Sheet